

REMARKS/ARGUMENTS

Claims 1-3, 7, 11-15, 22, and 23 remain in this application. Claims 1, 7, 11, 12, and 15, have been amended, without prejudice, and new claims 22 and 23 have been added. Support for the amendments can be found throughout the specification and claims, e.g., original claims 2, 3, and 6. Accordingly, no issues of new matter are believed to be raised by the above amendments to the claims.

Rejection Under 35 USC 112

Claims 12-21 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as invention.. See Page 2 of the Office Action. Accordingly to the Office Action "it is unclear what derivatives of isoascorbic acid and tocopherol are included in the instant claims." See page 2 of the Office Action. Applicant respectfully disagree.

"Tocopherol derivative" is defined on page 4, lines 25-29 of the specification as "tocopherol (e.g.,  $\alpha$ -tocopherol,  $\beta$ -tocopherol,  $\delta$ -tocopherol, and other unsaturated isomers thereof) and salts or esters thereof (e.g., tocopherol acetate)." "Isoascorbic acid derivative" is defined on page 5, lines 8-9 as "isoascorbic acid and salts and esters thereof." Thus, it is clear as to what derivatives are included within these two terms. Accordingly, Applicants respectfully request that this rejection under 35 USC 112 be withdrawn.

Rejection Under 35 USC 102

I

Claims 1, 2, and 4 were rejected under 35 USC 102 (b) as being anticipated by Yarosh (US 6,103,746). See Page 2 of the Office Action. According to the Office Action, "Yarosh teaches compositions, including topical compositions, for protecting mitochondria from oxidative damage." See Pages 2-4 of the Office Action. As set forth above, Applicant has amended Claim 1 to replace "oxygen labile active agent" with "retinol." Yarosh does not teach,

nor suggest, a composition comprising retinol and ergothioneine or Phellinus Linteus extract. Therefore, Yarosh does not teach every limitation of pending Claims 1 and 2. Accordingly, Applicants respectfully request that this rejection under 35 USC 102 be withdrawn.

## II

Claims 1, 2, and 5 were rejected under 35 USC 102(b) as being anticipated by Mohammadi (US6,039,935). See Page 3 of the Office Action. According to the Office Action, "Mohammadi teaches cosmetic sunscreen compositions containing ergothioneine in combination with tocopherol acetate and retinyl palmitate." See Page 3 of the Office Action. As discussed above, Applicant has amended Claim 1 to replace "oxygen labile active agent" with "retinol." Mohammadi does not teach, nor suggest, a composition comprising retinol and ergothioneine or Phellinus Linteus extract. Therefore, Mohammadi does not teach every limitation of pending Claims 1 and 2. Accordingly, Applicants respectfully request that this rejection under 35 USC 102 be withdrawn.

## **Rejection Under 35 USC 103**

### I

Claims 1, 3, 8-12 and 14-21 were rejected under USC 103(a) as being unpatentable over either Yanagida et al. (US 5,484,816) or Stahl et al. (US 6,468,552) in view of Kim et al. (KR 2001070531 A). See Pages 3-5 of the Office Action.

#### **1. Yanagida et al in view of Kim et al.**

According to the Office Action, "Yanagida et al. teach skin preparation comprising vitamin a (retinol), tocopherol, ascorbic acid and/or isoascorbic acid or a salt thereof . . . [and] Kim et al. teach using Phellinus Linteus extract as an anti-oxidant for skin aging prevention." See Page 4 of Office Action. The Office Action concludes that "it would obvious to one having ordinary skill in the art to modify the cosmetic compositions of Yanagida et al. such that to employ Phellinus Linteus extract." See page 4 of the Office Action. Applicants respectfully disagree.

Yanagida et al. does disclose formulations to stabilize retinol. Yanagida et al., however, specifically discloses fourteen embodiments of different classes of stabilizers for the retinol composition without ever mentioning ergothioneine or Phellinus Linteus extract. See col. 2, line 14 through col. 9, line 37. Kim et al. discloses Phellinus Linteus merely as antioxidant, but does not disclose, or suggest, its use for stabilizing retinol. Thus, one having ordinary skill in the art would not be motivated by Kim et al. to add Phellinus Linteus extract to stabilize Yanagida et al.'s retinol formulation as asserted in the Office Action.

In addition, Applicants found that compositions containing Phellinus Linteus extract were unexpectedly effective in stabilizing retinol. Formulae I and II in Example 1 contained a number of well-known anti-oxidants such as ascorbyl glucoside, tocopherol, and tocopherol acetate. As shown in Example 4, 38% of the initial concentration of retinol in Formula I and 7% of the initial concentration of retinol in Formula II was still lost in this formulation in one-month. However, Applicants found that only 4% of the initial concentration of retinol was lost in the formulation of Formula XIV of Example 3, which contained Phellinus Linteus. The only difference between Formula II and Formula XIV was the addition of Phellinus Linteus extract. As shown in Example 4, following one month of storage almost twice as much retinol degraded in Formula II as compared to Formula XIV and following three months of storage over three times as much retinol degraded in Formula II as compared to Formula XIV. Such an unexpected finding was not taught, nor suggested, by Yanagida et al. or Kim et al.

Accordingly, Applicants respectfully request that this rejection under 35 USC 103 be withdrawn.

## 2. Stahl et al. in view of Kim et al.

According to the Office Action, "Stahl et al. teach cosmetic compositions for treating skin disorders . . . comprising retinol . . . [and] Kim et al teach using Phellinus Linteus as an antioxidant." See Pages 4-5 of the Office Action. The Office Action concludes that "it would be obvious to one having ordinary skill in the art to modify the cosmetic compositions of Stahl et al. such that to employ Phellinus Linteus extract." See Page 5 of the Office Action. Applicants respectfully disagree.

As with Yanagida et al., Stahl et al. does disclose a formulation to stabilize retinol. Kim et al., however, discloses Phellinus Linteus merely as antioxidant, but does not disclose, or suggest, its use for stabilizing retinol. Thus, one having ordinary skill in the art would not be motivated by Kim et al. to add Phellinus Linteus extract to stabilize Stahl et al.'s retinol formulation as asserted in the Office Action.

In addition, as discussed above, Applicants found that compositions comprising Phellinus Linteus extract were unexpectedly effective in stabilizing retinol. Accordingly, Applicants respectfully request that this rejection under 35 USC 103 be withdrawn.

## II

Claims 1, 2, 4-7, 12, 15-21 were rejected under USC 103(a) as being unpatentable over either Yanagida et al or Stahl et al. in view of either Yarosh or Catroux et al. (US204/0047823) See Pages 5-6 of the Office Action. According to the Office Action, "Yarosh teaches using L-ergothioneine in topical compositions for protecting mitochondria from oxidative damage . . . [and] Catroux et al. teach using ergothioneine as an anti-pollution agent that protects the skin and keratin material from deleterious effects of oxidizing agents." See Pages 5-6 of Office Action. The Office Action concludes that "it would have been obvious to one having ordinary skill in the art at the time the inventions were made to modify the cosmetic compositions of either Yanagida et al. or Stahl et al. such that to exploit ergothioneine." See Page 6 of the Office Action.

Yarosh or Catroux et al. only teach using ergothioneine to stabilize living cells and skin tissues, not retinol. In addition, as with compositions comprising Phellinus Linteus, compositions containing ergothioneine were also unexpectedly found to be effective in stabilizing retinol. Applicants found that only 4% of the initial concentration of retinol was lost in the formulation of Formula XIII of Example 3, which contained ergothioneine. The only difference between Formula II and Formula XIII was the addition of ergothioneine. As shown in Example 4, following one month of storage almost twice as much retinol degraded in Formula II as compared to Formula XIII and following three months of storage over five times as much retinol degraded in Formula II as compared to Formula XIII. Such an unexpected finding was not taught, nor suggested, by Yanagida et al, Stahl et al., Yarosh or Catroux et al.

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Accordingly, Applicants respectfully request that this rejection under 35 USC 103 be withdrawn.

Applicant respectfully requests a timely Notice of Allowance be issued in this case.

Respectfully submitted,

By: William E. McGowan/  
William E. McGowan  
Reg. No. 39,301

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(732) 524-2197